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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/668,579  | 09/23/2003  | Gustav Tappe         | 07244-00144-US      | 3905             |
| 23416   | 7590        | 01/26/2005           | EXAMINER            |                  |
| CONNOLLY BOVE LODGE & HUTZ, LLP<br>P O BOX 2207<br>WILMINGTON, DE 19899 |             |                      | LE, HOA VAN         |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1752                |                  |

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/668,579

Applicant(s)

TAPPE ET AL.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 and 17 November 2004.  
2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13-24,28-38,40 and 41 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☒ Claim(s) 13-24,28-38,40 and 41 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☒ Certified copies of the priority documents have been received in Application No. 09/865,880.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

This is in response to Amendments filed on 10 and 17 December 2004.

A. Applicants state on the record that the claims have been amended to emphasis on the step of “to be diluted with water before use” or “diluting...with water” to be distinct from the applied prior art on the record.

B. The step of “to be diluted with water before use” or “diluting...with water” as newly added is given full value for consideration and search in the method claims 29-37 and 40 as clearly pointed out and set forth on the record. Accordingly, the restriction is made as followed:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 13-24, 28 and 38 drawn to material, classified in class 430, subclass 460.
- II. Claims 29-37, drawn to method of stabilizing with the newly added step of diluting with water, classified in class 430, subclass 440. The newly added step of diluting with water required a separate consideration and search from that of the material claims in Group I above.
- III. The newly added claimed subject mater in the newly added claims 40-41 (has not been considered or searched on the record), drawn to regenerating process, classified in class 430, subclass 400.

Inventions Groups II and III are related to the processes but have the patentably different and distinct processing steps and utilized instruments have acquired the separate status and searches in the art and can be supported the separate patents as divided by

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applicants. Restriction for examination as indicated is proper.

Inventions Group I and II are related as process of making or stabilizing and product made. The inventions are distinct if either or both of the following can be shown: (1) that the making or stabilizing process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the claimed product can be traded or made without the requirement of the step of further diluting with water as that in the processing step claims

Inventions Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the claimed product can be traded or use as original bleach-fixing composition instead of a bleach-fixing replenishing or regenerating composition that in the processing claims.

Because these inventions are distinct for the reasons given above and have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants. Restriction for examination purposes as indicated is proper. Applicant should show or provide convincing evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

C. An additional consideration or search for more than one invention or subclass in the art is (1) burdensome, (2) lacks focus and (3) dilutes many claimed embodiments in detail in multiple claimed inventions as compared to those in one invention

D. Applicant is advised that the reply to this requirement to be complete must include an election of one invention to be examined even though the requirement be traversed (37 CFR 1.143). No search will be made if an election one invention is not made or is improper.

E. Other issues have not been considered until a full and proper election of one invention is made and resolved.

F. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

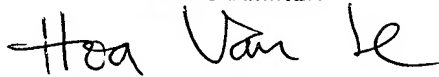
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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le  
Primary Examiner  
Art Unit 1752

HVL  
25 January 2005

HOA VAN LE  
PRIMARY EXAMINER

A handwritten signature in black ink that reads "Hoa Van Le". The signature is written in a cursive, flowing style.